



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,643	04/06/2001	Brian J. Roberts	12406/102	5505

7590 11/25/2005

ANDREW L REIBMAN, ESQ
KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

HOTALING, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

3714

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,643

Applicant(s)

ROBERTS, BRIAN J.

Examiner

John M. Hotaling II

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 59 and 60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 59 contains a claim element " wherein the game ticket is a future draw lottery ticket having indicia which are matched against a future drawing event to determine if the lottery ticket is a winner of the separate ticket based lottery game." After a comprehensive review the specification does not enable this claim limitation.

Claim 60 contains the claim element "wherein whether the game ticket wins the jackpot game is determined randomly at the time the game ticket is dispensed". After a comprehensive review the specification does not enable this claim limitation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 50 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 50 claims of the system.

Claim 50 recites the limitation " the sub-system ". There is insufficient antecedent basis for this limitation in the claim. It appears that this claim may have been intended to depend from claim 49.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerow US Patent 5,944,606 in view of Koza et al US Patent 5,112,050, in further view of Weingardt US Patent Re. 35,864. Gerow discloses that many state lotteries fall into the progressive category because the prize increases over time as more players participate 1:45-55. Gerow discloses a gaming system (100) comprising game ticket (10, 10') for the play of a jackpot game together with a separate ticket-based lottery game, which comprises an indicia for use in the play of a lottery game, and a machine-readable ticket identifier (22') for use in the play of a progressive jackpot game, 4:49-51. System 100 includes a control system 120 to which each of the units are operatively connected, such as by a serial cable 122. In the preferred embodiment, control system 120 is an IBM compatible computer running software known as Progressive Pull-Tab Version 1.3, produced by

Paradise Valley Electronics, of Moscow, Id., that allows the control system to communicate with each of the dispensing units, although any suitable software could be used. Control system 120 monitors the quantity of pull-tab cards dispensed by the dispensing units. In the preferred embodiment, each unit signals the control system when a player purchases cards and when a card is dispensed. Also in the preferred embodiment, the control system is physically separated from the dispensing units, but it could just as well be incorporated in one of the dispensing units, or each unit could have its own control system. As an additional alternative, cards could be directly sold and distributed by a cashier or operator. System 100 also includes a jackpot display 130 operatively connected to the control system to display a jackpot value. In the preferred embodiment, the software on the control system keeps track of the jackpot value and sends information to the jackpot display. The redemption value of the jackpot card is determined by the jackpot value. In the preferred embodiment of the invention, the jackpot is set to a predetermined value at the beginning of the game, that is, when a new set of cards is loaded into the system to be dispensed. As the control system receives signals indicating sale of cards, it increases the jackpot value. For instance, the jackpot value may be incremented by five-percent of the price of each card, as they are sold. Although the jackpot value is incremented for every card sale in the preferred embodiment, it could be incremented less frequently, or additionally on occurrence of other events. For example, the jackpot could be incremented once for every five card sales or once every fifteen minutes, or both. In the preferred embodiment, the jackpot value is incremented by and stored in software in the computer, but the jackpot could be

Art Unit: 3714

as simple as a mechanical counter that was incremented for every ticket sale or some fraction thereof. Players receiving winning cards before or after the jackpot card is dispensed are able to redeem them for the predetermined value of the card. Thus, although the jackpot may have been awarded, the play of the game may continue until all the cards are dispensed, with the draw for players being the remaining winning cards. Alternatively, the game could be stopped as soon as the jackpot card is dispensed, or after all winning cards have been redeemed. In the preferred embodiment, the control system may be connected to a large number of dispensing units. The control system, using identification codes and software is able to segregate these dispensing units into various groups of one or more machines. Each group can then be used to play an independent game. Thus, if there are twenty-one dispensing units connected to the control system, they may be divided into two groups of five, a group of ten, and a group of one. Each group would then have an independent jackpot display and separate gaming set. Preferably, of course, the group with ten dispensing units would be used with a gaming set having ten times as many cards as the gaming set for the group with one dispensing unit. In a progressive game it can be desirable to link multiple machines, and therefore more players, in a single game because the associated potential jackpot will generally go up with the number of cards making up the game. In the preferred embodiment, the operator is provided with complete flexibility to control the parameters of the jackpot using the control system. In particular, the operator of the game can, using the software running on the control system, select the initial value of the jackpot, i.e., \$0 or \$500. In the preferred embodiment the operator is

Art Unit: 3714

also able to select an increment percentage for each sale of a pull-tab card. Such values might range from a few percent to 25-percent or more. If the value was 10-percent, then for \$1 cards the jackpot would be increased by 10% for every pull-tab card sale. The values are selected to make the game appeal to players and maintain a profit for the operator. Thus, a large initial jackpot value may be used in conjunction with a smaller percentage increment. On the other hand, a large percentage increment may be used with a small initial value. The control system is also able to track total sales and various auditing data from the dispensing units. Additionally, a card reader may be internal to the dispenser and simply read the card or backing strip prior to expelling the pull-tab card. Preferably, the card reader is incorporated in the dispensing unit so that the dispensing unit can be configured to provide game credits for winning cards, thereby allowing the play to continue to play. Alternatively, the dispensing unit could issue cash or vouchers redeemable with a cashier for winning cards. As an additional alternative, the pull-tab cards could be dispensed by a dispensing unit and a separate card reading unit, similar to dispensing unit 102' above but without the dispensing capability, could be used to redeem the cards. As described in figure 8 and column 6 that after dispensing a card from the machine the machine will display to the recipient of the card if the card is a winner. Gerow does not disclose a multi-jurisdictional game and the communication specifics with the central computer. Instead, Gerow discloses that many state lotteries fall into the progressive category because the prize increases over time as more players participate and the control system is also able to track total sales and various auditing data from the dispensing units. This would provide motivation for one of ordinary skill

in the art to find other progressive game systems where auditing data may be exchanged and the progressive system more fully explained. In an analogous system Koza teaches a lottery system comprising a memory (15) for holding coded value, 4:50-62. Koza further teaches a comparator for comparing coded value to indicate (16) a match condition, 4:50-62. Upon a matching condition, Koza discloses using audio/visual alarm to provide the indication, 4:50-62. FIG. 6 is a diagram showing a selection of a value by the player, an assignment of the selected value to the ticket by an impregnating device, and a recording of such selection at a central information repository. In FIG. 6, an apparatus 70 (i.e. the game ticket) is presented by a player at the retail location. The apparatus 70 is connected to an impregnating device 71 via a connector 76 of the apparatus 70 and connector 77 of the impregnating device 71. A keyboard 72 coupled to the impregnating device 71 allows the entry of the values of the game desired by the player. This keyboard may be operated by either player or a clerk and be part of a vending machine and could further be with a coin slot. The impregnating device 71 causes signals to be created and transmitted to the apparatus 70 and entered into a memory resident on the apparatus 70. The EEPROM of the microprocessor controller chip 57 will provide that function when controller chip 57 is used in the apparatus 70. Appropriate validation and security codes accompany the game values to assure the validity of the game values in event of a win. Before a prize is paid, the stored game values of the player must qualify for a prize given the broadcast values and, in addition, the stored game values must agree with an encrypted version of the stored game values in the apparatus, as well as with a record 73 of the stored game

value and an additional validation code created at the time of issuance of the game value, retained at a central site operated by the sponsor of the game. It is appreciated that the earlier described apparatus of FIGS. 4 and 5 can be readily used to provide apparatus 70. It is to be noted that it is also possible that the player could choose to allow the impregnating device to randomly generate the new game values for his apparatus (i.e. the easy pick) and impregnate such new random values in his apparatus. Also the new game values could be supplied via a separate paper game ticket, in the form of an optically scannable printed bar-code, optically readable printed characters, information encoded on a magnetic strip or other such means. The impregnating device 71 creates a record 73 of issuance of the game value selected by the player. The record of issuance would typically be a signal sent via dedicated telephone lines to a central computer maintained by the sponsor of the lottery or promotional game; however, this record of issuance could also be in the form of a printed paper record or a magnetic memory device (such as a floppy disk). This signal contains the game values selected, as well as the time and date of issuance and other administrative information appropriate to the game. Finally, it is possible for the game values to be generated by the controller chip 57 itself using a program. This program would generate a sequence of game values using a pseudo-random algorithm. Such pseudo-random algorithms are well known in the prior art and are capable of generating a sequence of seemingly random, seemingly unpredictable, and seemingly unrelated game values. However, in fact, the entire sequence of such seemingly random values is generated in an entirely deterministic way by the mathematical algorithm involved and

Art Unit: 3714

thus capable of precise verification of validity in event of a win. Then, as each new winning value is broadcast, the apparatus determines whether the newly computed, seemingly random stored value in the apparatus is a winner in the game given the broadcast values. Thus, the stored values of the game in the ticket apparatus may arise in any one of the three ways, namely, created at the time of manufacture, created as a result of a selection and request initiated by the player, or internally created by the microprocessor controller in the apparatus just prior to the broadcast of the winning values. Koza also discloses the use of a modem 6:63 and a printer for printing tickets and receipts column 2. In an analogous reference to Weingardt discloses that a lottery type game can be used in a multi-jurisdictional game environment and advantageously discloses the history and use of pari-mutuel pools including seeding pools and secondary (or shadow) for additional jackpots associated with the same game. Weingardt teaches a gaming system using a progressive jackpot to award players. Weingardt further teaches providing funding of future pools by setting aside into future pools portions of wagers made by current players (see abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the communications and encryptions taught by Koza with the multi-jurisdictional and seeding/shadow in relation to the second prize pool teaching as taught by Weingardt using the motivation provided by Gerow discloses that many state lotteries fall into the progressive category because the prize increases over time as more players participate and the control system is also able to track total sales and various auditing data from the dispensing units. This would provide motivation for one of ordinary skill in the art to

find other progressive game systems where auditing data may be exchanged and the progressive system more fully explained.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sarno '641, Bouedec '684, and Sanchez '000 disclose lottery systems

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Hotaling II whose telephone number is (571) 272 4437. The examiner can normally be reached on Mon-Thurs 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272 3507. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JOHN M. HOTALING, II
PRIMARY EXAMINER**

November 17, 2005